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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,100	03/03/2004	Giuseppe Maio	1610-100	4098
30448	7590	12/16/2008		
AKERMAN SENTERFITT P.O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER	
			PURDY, KYLE A	
			ART UNIT	PAPER NUMBER
			1611	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/792,100

## Applicant(s)

MAIO ET AL.

## Examiner

Kyle Purdy

## Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/2008 has been entered.

### ***Status of Application***

2. The Examiner acknowledges receipt of the amendments filed on 10/19/2008 wherein claims 1, 2, 6 and 7 have been amended and claim 5 has been cancelled.

3. Claims 1-4 and 6-10 are pending, claim 10 remains withdrawn and claims 1-4 and 6-9 are presented for examination on the merits. The following rejections are made.

### ***Response to 132 Declaration***

4. The declaration under 37 CFR 1.132 filed 10/19/2008 is insufficient to overcome the rejection of claims 1-4 and 6-9 based upon the rejection as set forth in the last Office action.

5. Applicants declaration suggests that the combination of a polyisoprene with a molecular weight (MW) of between 100,000 and 4,000,000; an oleophylic smectite clay; and an aliphatic hydrocarbon results in a composition with high-film forming properties and suitable for the application to the skin, lips and eyelashes.

6. In the filed declaration there are 4 examples: 513.32, 513.33, 513.34 and 513.35. 513.32 contains a polyisoprene (MW of 100,000), disteardimonium hectorite and isodecane. 513.33 is identical to 513.32, except for it lacks disteardimonium hectorite. 513.34 is the same as 513.32,

except for the polyisoprene is a polyisoprene latex, and 531.35 is identical to 513.32 except that the polyisoprene has a MW of about 400.

7. With respect to the result for 513.33, this is not sufficient to overcome the rejection. Applicant has not shown how the disteardimonium hectorite (Bentone) is distinguished from other species such as xanthan gum and polyacrylic acid. All Applicant has shown is that the final composition with Bentone has better properties than a composition lacking Bentone. As was noted in the previous office action, it is the position of the Examiner that disteardimonium hectorite is a functionally equivalent thickener to other thickeners such as xanthan gum and polyacrylic acid. It would have readily occurred to any person of ordinary skill in the art to substitute one for the other with a reasonable expectation for success.

8. With respect to the result for 513.34, this too is insufficient to overcome the rejection of record. While it is acknowledged that the composition containing polyisoprene latex has properties that are not as good as non-latex polyisoprene containing composition, the instant claims do not reflect the showing of the current example, i.e. the species of polyisoprene being non-latex polyisoprene. Rather, the instant claims recite that the composition is to consist of, among other ingredients, polyisoprene obtainable by a process wherein the final product is polyisoprene with a MW of between 100,000 and 4,000,000. There is nothing in the claim language which precludes the polyisoprene as being a polyisoprene latex. Moreover, even if the claim reflected such language, it would be well within the skill of one of ordinary to utilize isolated polyisoprene as it is taught that it's the polymer of the latex emulsion that is required for the skin compatibility (see column 1, lines 1-10).

9. Example 531.35 illustrates that the properties of a polyisoprene composition wherein the polyisoprene has a MW of about 400 are not as good as a composition with a polyisoprene having a MW 100,000. However, as the MW of polyisoprene was a non-issue in the rejection of record, this formulation will not be discussed.

*Response to Applicants' Arguments*

10. Applicants arguments filed 10/19/2008 regarding the rejection of claims 1-8 made by the Examiner under 35 USC 112, second paragraph have been fully considered and they are found persuasive. This rejection has been overcome by amendment.

11. Applicants arguments filed 10/19/2008 regarding the rejection of claims 1-9 made by the Examiner under 35 USC 103(a) over Veeger et al. (US 6471983) as evidenced by Kraton IR401 in view of Viladot (US 2003/0044469) have been fully considered but they are not found persuasive. This rejection is **MAINTAINED** for the reasons of record in the office action mailed on 06/18/2008.

12. In regards to the 103(a) rejection, Applicant asserts the following:

- A) Water is present in the composition of Veeger which is contrary to the present claims; and
- B) The presence of polyisoprene latex compromises the quality of the composition, and is contrary to Applicants invention.

13. In response to assertion A, the instant claims do not exclude the presence of water. It is acknowledged that the claim language has been changed from 'comprising' to 'consisting of'. However, Applicant is directed to claim 1 which states that the balance of the composition comprises conventional cosmetic excipients and additives. It is well known that water is a

conventional excipient and additive in cosmetic compositions. Thus, while the presence of water may be contrary to Applicants invention, the claims do not set forth such a limitation.

14. In response to assertion B, and as noted above for the response to the 132 declaration, the instant claims do not limit the composition so as to preclude polyisoprene latex. The amended claim sets recite a product-by-process wherein the final product is a polyisoprene polymer with a MW of between 100,000 and 4,000,000. The polyisoprene utilized by Veeger, despite being a latex, meets the properties stipulated by the claims. If Applicant intends to exclude polyisoprene latex from the scope of the claims, then Applicant modify their claims to reflect such. As of now, there is no reason to believe that polyisoprene latex is not be encompassed by the claims. Applicants arguments are not found persuasive.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**16. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Veeger et al (6,471,983; of record) as evidenced by Kraton IR 401 brochure of record in view of Viladot (20030044469; of record).**

17. Veeger teaches skin composition comprising a) 10-80% polyisoprene, b) 1-15% by weight of an organic solvent such as a hydrocarbon with 12-22 carbons (isododecane is C12), c) 0-10% by weight of at least one surfactant, d) 0-10% by weight of an abrasive, e) 0-1% by

weight thickener, f) optionally cosmetic adjuvants and additives and/or active ingredients, g) 10-60% by weight water, to make a total of 100% by weight. See tables and claims. The isoprene utilized is Kraton IR 401. Veeger teaches the use of thickeners such as acrylic acid polymers and xanthan gum to modify the consistency of the composition. The surfactant may be a fatty alcohol ethoxylate. See column 2, lines 3-9. The composition may contain other actives such as emollients, care actives, etc.

18. Although Veeger teaches kaolin (clay) in the composition, Veeger does not teach the use of modified clay.

19. The Kraton IR 401 brochure discloses that Kraton IR 401 has a molecular weight of 1,500,000-2,500,000 and a particle size of 1.8 microns.

20. Viladot teaches a skin care composition comprising consistency factors and thickeners such as xanthan gum, polyacrylate polymers, disteardimonium hectorite (BENTONE), etc. see [0058]. Further, Viladot teaches conventional excipients including emulsifiers such as nonionic surfactants including wool wax and fatty alcohol ethoxylates. Other conventional excipients include silicone oils.

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Veeger et al and Viladot and substitute the prior art's thickener with the instant thickener, disteardimonium hectorite. One would have been motivated to do so since Viladot teaches both Veeger's exemplified thickeners and instant thickener function as consistency factors in cosmetics. Moreover, a skilled artisan would have reasonably expected success since Veeger generally teaches using thickeners to modify the consistency of

the cosmetic. Therefore, it would have been *prima facie* obvious for a skilled artisan to utilize the appropriate thickener since the prior art establishes the functional equivalency between both. Regarding claim 8, Veegeer teaches the use of fatty alcohol ethoxylates as nonionic surfactants in the amount of 0-10% and Viladot teaches wool wax alcohols and fatty alcohol ethoxylates function as nonionic surfactants. Therefore, it would have been *prima facie* obvious for a skilled artisan to utilize the appropriate surfactant since the prior art establishes the functional equivalency between both.

### ***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/  
Examiner, Art Unit 1611  
December 11, 2008*



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/David J Blanchard/  
Primary Examiner, Art Unit 1643